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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant(s): Takaaki AMANO
Serial No.: 09/863,877
Filed: May 23, 2001
For: **ADVERTISEMENT INFORMATION SUPPLYING SYSTEM**
Examiner: Jean D. Janvier
Group Art Unit: 3622
Confirmation No.: 9471
Attorney Docket No.: 100809-16253 (SCET 18.699)

February 14, 2007

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

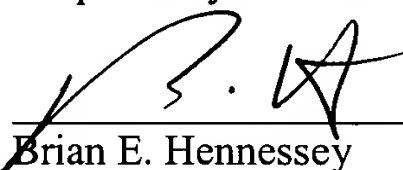
BRIEF ON APPEAL COVER LETTER

SIR:

Enclosed herewith is a Brief on Appeal in triplicate and charge the Deposit Account No. 50-1290 the fee of \$350.00.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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Docket No.: 100809-16253 (SCET 18.699)

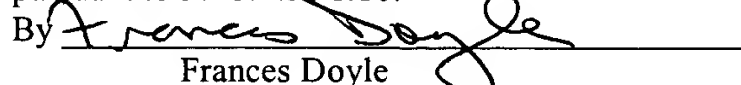
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pursuant to 37 C.F.R. 1.10.

By 
Frances Doyle



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APPEAL BRIEF FOR APPELLANT

Board of Patent Appeals and Interferences
Assistant Commissioner for Patents
Washington, D.C., 20231

Sir:

A Notice of Appeal was filed on December 20, 2006. Appellant hereby appeals to the Board of Patent Appeals and Interferences from the Examiner's Decision, in the Official Action dated July 24, 2006, finally rejecting claims 1 and 4-10.

All requisite fees, including those for this Brief set forth in 37 C.F.R. § 41.20(b)(2), may be charged to Deposit Account No. 50-1290.

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pursuant to 37 C.F.R. § 41.20.
By Frances Doyle
Frances Doyle

I. Real party in interest

The real party in interest is Sony Computer Entertainment Inc., a Japanese corporation with offices at 1-1, Akasaka 7-chome, Minato-ku, Tokyo, Japan.

II. Related appeals and interferences

Upon information and belief, there are no other appeals or interferences, which will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. Status of claims

Claims 1 and 4-10 are pending.

Claims 2 and 3 have been canceled.

Claims 1 and 4-10 are rejected.

Claims 1 and 4-10 are appealed.

IV. Status of amendments

Appellant filed a response to the final Office Action of July 24, 2006, on October 18, 2006, including amendments to claims 1 and 4-10. The Advisory Action dated November 16, 2006, indicates that the amendments are entered. Appellant did not otherwise cancel or amend any of the claims that are the subject of this appeal.

V. Summary of claimed subject matter

Claim 1 recites an advertisement supplying system (figures 1 and 2, element 10; specification, page 10, line 4, to page 11, line 24) for displaying a point which gives viewing persons an incentive to view an advertisement (figure 11, element 342; specification; page 33, lines 14-21) in combination with advertisement information on a terminal apparatus (figure 1, element 30) connected thereto via a computer network (figure 1, element 40). The system of claim 1 includes storage means (figures 1 and 2, element 10) for storing therein identification information of a customer (figure 2, element 22) and a point degree owned by the customer (figure 2, element 21) in relation to each other, and display point degree determining means for determining a display point degree (specification; page 34, line 7, to page 34, line 3) to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer (specification; page 11, lines 19-24) and the display point degree with reference to a predetermined rule. In the system of claim 1, said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information (figure 12; specification; page 35, line 16, to page 37, line 5), and the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement (figure 12; specification; page 36, lines 7-9 and lines 15-20).

Claim 5 recites an advertisement supplying system (figures 1 and 2, element 10; specification, page 10, line 4, to page 11, line 24) for displaying a point which gives viewing persons an incentive to view an advertisement (figure 11, element 342; specification; page 33, lines 14-21) in combination with advertisement information on a terminal apparatus (figure 1,

element 30) connected thereto via a computer network (figure 1, element 40), comprising:
storage means (figures 1 and 2, element 10) for storing (figure 2, element 22) therein
identification information of a customer and personal information related to the customer in
relation to each other; means for accepting the identification information of the customer from a
terminal apparatus of the customer; means for acquiring the personal information related to the
customer from said storage means, said personal information being related to the accepted
identification information of the customer; and display point degree determining means for
determining a display point degree (specification; page 34, line 7, to page 34, line 3) to be
displayed in combination with the advertisement information based upon a relationship between
the point degree owned by the customer (specification; page 11, lines 19-24) and the display
point degree with reference to a predetermined rule; wherein said rule being that a point degree
owned by the customer (figure 2, element 21) increases in response to the customer selecting the
advertisement and the display point degree decreases for display in combination with a
subsequent display of the advertisement information (figure 12; specification; page 35, line 16,
to page 37, line 5), and the display point degree does not decrease to zero for the subsequent
display of the advertisement information in response to the customer first selecting the
advertisement (figure 12; specification; page 36, lines 7-9 and lines 15-20).

Claim 8 recites a computer readable medium for causing a computer to function as an
advertisement supplying system (figures 1 and 2, element 10; specification, page 10, line 4, to
page 11, line 24) for displaying a point which gives viewing persons an incentive to view an
advertisement (figure 11, element 342; specification; page 33, lines 14-21) in combination with
advertisement information on a terminal apparatus (figure 1, element 30) connected thereto via a
computer network (figure 1, element 40), the computer readable medium having encoded thereon

computer codes which when executed on a processor perform the steps of: storing identification information (figure 2, element 22) of a customer and a point degree owned by the customer (figure 2, element 21) in relation to each other; accepting the identification information of the customer from a terminal apparatus of the customer; acquiring the point degree owned by the customer related to the accepted identification information of the customer; and determining a display point degree (specification; page 34, line 7, to page 34, line 3) to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer (specification; page 11, lines 19-24) and the display point degree with reference to a predetermined rule; wherein said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information (figure 12; specification; page 35, line 16, to page 37, line 5), and the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement (figure 12; specification; page 36, lines 7-9 and lines 15-20).

Claim 9 recites a computer readable medium for causing a computer to function as an advertisement supplying system (figures 1 and 2, element 10; specification, page 10, line 4, to page 11, line 24) for displaying a point which gives viewing persons an incentive to view an advertisement (figure 11, element 342; specification; page 33, lines 14-21) in combination with advertisement information on a terminal apparatus (figure 1, element 30) connected thereto via a computer network (figure 1, element 40), the computer readable medium having encoded thereon computer codes which when executed on a processor perform the steps of: storing identification information (figure 2, element 22) of a customer and personal information related to the

customer in relation to each other; accepting the identification information of the customer from a terminal apparatus of the customer acquiring the personal information related to the customer, said personal information being related to the accepted identification information of the customer; and determining a display point degree (specification; page 34, line 7, to page 34, line 3) to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer (specification; page 11, lines 19-24) and the display point degree with reference to a predetermined rule; wherein said rule being that a point degree owned (figure 2, element 21) by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information (figure 12; specification; page 35, line 16, to page 37, line 5), and the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement (figure 12; specification; page 36, lines 7-9 and lines 15-20).

Claim 10 recites a method of displaying a point in an advertisement supplying system (figures 1 and 2, element 10; specification, page 10, line 4, to page 11, line 24) which gives viewing persons an incentive to view an advertisement (figure 11, element 342; specification; page 33, lines 14-21) in combination with advertisement information on a terminal apparatus (figure 1, element 30) connected thereto via a computer network (figure 1, element 40), the method comprising the steps of: a) storing identification information (figure 2, element 22) of a customer and a point degree owned by the customer (figure 2, element 21) in relation to each other; b) accepting the identification information of the customer from a terminal apparatus of the customer; c) acquiring the point degree owned by the customer from said storage means, said owned point degree being related to the accepted identification information of the customer; d)

determining a display point degree (specification; page 34, line 7, to page 34, line 3) to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer (specification; page 11, lines 19-24) and the display point degree with reference to a predetermined rule; wherein said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information (figure 12; specification; page 35, line 16, to page 37, line 5), and the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement (figure 12; specification; page 36, lines 7-9 and lines 15-20).

VI. Grounds of rejection to be reviewed on appeal

1. Whether or not claims 1 and 4-10 are unpatentable under 35 U.S.C. 103(a) based on United States Patent No. Patent 5,794,210 to Goldhaber (also referred to hereinafter as the "Goldhaber Patent") in view of PCT Application No. WO 98/34189 to Roth et al. (also referred to hereinafter as the "Roth Application").

2. Whether or not claim 4 is indefinite under 35 U.S.C. 112, Second Paragraph.

VII. Argument

1. Claims 1 and 4-10 are patentable under 35 U.S.C. 103(a) over the Goldhaber Patent in view of the Roth Application.

a. Neither the Goldhaber Patent nor the Roth Application disclose or suggest the feature of the display point degree not decreasing to zero for subsequent display of the advertisement information in response to the customer first selecting the advertisement.

The Examiner admits that the Goldhaber Patent does not disclose the feature of claim 1 of “the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement” (Office Action dated July 24, 2006; page 9, lines 14-17). The Examiner asserts that this feature is disclosed in the Roth Application, and discusses the features of the instant claims at page 14 of the Office Action dated July 24, 2006, citing the Roth Application (Roth; page 26, line 6 to page 29, line 4 and figures 5 and 6). The cited sections of the Roth Application apparently discuss bidding on advertisements for viewers, and mentions advertisement rotation, advertisement frequency, and repeat viewers. However, the cited sections and figures of the Roth Application do not give any disclosure or suggestion regarding the display of an advertisement *to the customer for a subsequent viewing*, nor more particularly any characteristic of such display *after a first selection*. The Examiner further cites to the Roth Application as disclosing a bid for a view opportunity going from 5 cents per view to 1 cent per view (Roth; page 3, line 19 to page 4, line 10). However, this section of the Roth Application does not relate to the same viewer (as claimed, “the customer”), but instead discusses the first thousand viewings being valued at 5 cents and subsequent viewings being valued at 1 cent. There is no mention that the first

thousand, or the subsequent viewings, are *by the same customer*. In contrast, the present invention discusses *the change in a display point degree for a customer*.

Furthermore, the Examiner admits in the Advisory Action dated November 16, 2006, that “Roth does not expressly state that the subsequent viewings are from the same viewers who read the advertisement during a first period of time ...” (Advisory Action dated November 16, 2006; page 2, lines 17-18). The Examiner concludes that “... Applicant cannot hastily conclude that the subsequent viewings are from different viewers.” (Advisory Action dated November 16, 2006; page 2, lines 18-19). However, this misconstrues 35 U.S.C. 103(a). A prima facie rejection based on obviousness requires, *inter alia*, that the prior art references teach or suggest *all* the claim limitations. Since the Examiner has admitted that both the Goldhaber Patent (Office Action dated July 24, 2006; page 9, lines 14-17) and the Roth Application (Advisory Action dated November 16, 2006; page 2, lines 17-18) do not disclose “the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement”, the Examiner has not made a prima facie showing of obviousness. Therefore, the rejection of claims 1 and 4-10 based on the Goldhaber Patent and the Roth Application should be withdrawn.

b. There is no motivation to combine the Goldhaber Patent and the Roth Application.

Appellant respectfully submits that there is no proper motivation to combine the Roth Application and the Goldhaber Patent. The motivation to combine the references provided in the Office Action dated July 24, 2006 is apparently a restatement of the advantages of the present invention (Office Action dated July 24, 2006; page 14, line 21 to page 15, line 11). The Office Action dated July 24, 2006 merely states that an ordinarily skilled artisan would have been

motivated to display an ad to a user more than once until the user responds to the ad. However, this conclusory reasoning is insufficient to support a claim of obviousness.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

It is respectfully submitted that the present rejection does not provide a proper motivation to combine the references since it does not show why a person of ordinary skill in the art would choose to combine the two distinct references, *in the particular manner claimed*. The Roth Application relates to an internet advertisement system, while the Goldhaber Patent relates to an attention brokerage system. However, there is no motivation in the Roth Application to suggest a combination with the Goldhaber Patent, or vice versa. There must be *specific teaching* to motivate a person of ordinary skill in the art to combine the prior art teachings *in the particular manner claimed*.

The Examiner responds in the Advisory Action by citing United States Patent No. 5,848,396 to Gerace (hereinafter referred to as the “Gerace Patent”) (Advisory Action dated November 16, 2006; page 2, lines 21-23). However, the cited section of the Gerace Patent merely states:

In accordance with another aspect of the present invention, there is a module (e.g., advertisement module) that records history of users viewing the advertisements. For each advertisement, the module

records (i) *number of times viewed by a user*; (ii) number of times selected for further information by a user, and/or (iii) number of purchases initiated from display of the advertisement to a user.

(Gerace; col. 2, lines 36-42; emphasis added). There is no discussion in the Gerace Patent suggesting a motivation to combine the attention brokerage system of the Goldhaber Patent with the internet advertisement system of the Roth Application. There is no motivation provided in the Goldhaber Patent to combine its teaching with the Roth Application. There is also no indication of the feasibility of combining the Goldhaber Patent and the Roth Application, nor the manner of making such a combination.

Therefore, since there is no motivation to combine the references, the rejection is improper and should be withdrawn. In view of the foregoing, it is respectfully submitted that claims 1 and 4-10 are patentable over the Goldhaber Patent in view of the Roth Application for at least the above-stated reasons.

2. Claim 4 is definite under 35 U.S.C. 112, Second Paragraph.

Claims 4 was rejected under 35 U.S.C. 112, Second Paragraph, in the Office Action dated July 24, 2006, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner indicates in the Advisory Action, that the 35 U.S.C. 112, Second Paragraph, rejection of claim 4 has been withdrawn (Advisory Action dated November 16, 2006; page 2, lines 2-6). However, the Examiner also indicates in the same passage that claim 4 remains unclear. Appellant therefore respectfully requests guidance from the Board of Appeals that the claim as presented is definite.

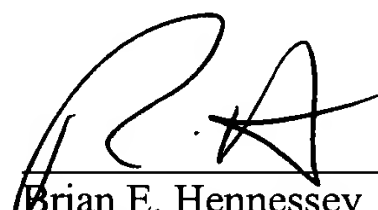
The Examiner asserted in the Office Action dated July 24, 2006, that claim 4 is inconsistent with a feature of claim 1 by stating that the point degree to be displayed is equal to

zero, whereas claim 1 states that the point degree does not decrease to zero (Office Action; page 3, lines 21-24). However, claim 1 states that the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement, and therefore does not indicate that the point degree never decreases to zero. Claim 4 recites that "a minimum value of the point degree to be displayed is equal to 0", which is consistent with the feature of claim 1 relating to the adjustment to the display point degree for the first selection of the advertisement. Therefore the claim is not inconsistent as presented and Appellant respectfully requests that Board indicate that the claim is definite.

CONCLUSION

Claims 1 and 4-10 are patentable over the Goldhaber Patent in view of the Roth Application. Accordingly, it is respectfully submitted that the Examiner erred in rejecting claims 1 and 4-10 and a reversal of such rejections by this Honorable Board is solicited.

Respectfully submitted,



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Docket No.: 100809-16253 (SCET 18.699)
BEH:fd



VIII. Claims Appendix

I. An advertisement supplying system for displaying a point which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, comprising:

storage means for storing thereinto identification information of a customer and a point degree owned by the customer in relation to each other;

means for accepting the identification information of the customer from a terminal apparatus of the customer;

means for acquiring the point degree owned by the customer from said storage means, said owned point degree being related to the accepted identification information of the customer; and

display point degree determining means for determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.

4. The advertisement supplying system as claimed in claim 1 wherein:
a minimum value of the point degree to be displayed is equal to 0.

5. An advertisement supplying system for displaying a point which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, comprising:

storage means for storing thereinto identification information of a customer and personal information related to the customer in relation to each other;

means for accepting the identification information of the customer from a terminal apparatus of the customer;

means for acquiring the personal information related to the customer from said storage means, said personal information being related to the accepted identification information of the customer; and

display point degree determining means for determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.

6. The advertisement supplying system as claimed in claim 5 wherein:

the personal information related to the customer corresponds to information as to at least any one of a sex of the customer, an age thereof, and a taste thereof.
7. The advertisement supplying system as claimed in claim 1 wherein:

a sort of point degree selected by the display point degree determined means; and

the display point degree determined by said display point degree determining means is selected from the sort of point degrees selected by the display point degree means.
8. A computer readable medium for causing a computer to function as an advertisement supplying system for displaying a point which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, the computer readable medium having encoded thereon computer codes which when executed on a processor perform the steps of:

storing identification information of a customer and a point degree owned by the customer in relation to each other;

accepting the identification information of the customer from a terminal apparatus of the customer;

acquiring the point degree owned by the customer related to the accepted identification information of the customer; and

determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.

9. A computer readable medium for causing a computer to function as an advertisement supplying system for displaying a point which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, the computer readable medium having encoded thereon computer codes which when executed on a processor perform the steps of:

storing identification information of a customer and personal information related to the customer in relation to each other;

accepting the identification information of the customer from a terminal apparatus of the customer

acquiring the personal information related to the customer, said personal information being related to the accepted identification information of the customer; and

determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.

10. A method of displaying a point in an advertisement supplying system which gives viewing persons an incentive to view an advertisement in combination with advertisement information on a terminal apparatus connected thereto via a computer network, the method comprising the steps of.

a) storing identification information of a customer and a point degree owned by the customer in relation to each other;

b) accepting the identification information of the customer from a terminal apparatus of the customer;

c) acquiring the point degree owned by the customer from said storage means, said owned point degree being related to the accepted identification information of the customer;

d) determining a display point degree to be displayed in combination with the advertisement information based upon a relationship between the point degree owned by the customer and the display point degree with reference to a predetermined rule; wherein

said rule being that a point degree owned by the customer increases in response to the customer selecting the advertisement and the display point degree decreases for display in combination with a subsequent display of the advertisement information, and

the display point degree does not decrease to zero for the subsequent display of the advertisement information in response to the customer first selecting the advertisement.

IX. Evidence Appendix

No evidence was submitted to or entered by the Examiner during prosecution of this application.

X. Related Proceedings Appendix

No appeals or interferences, which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal, are identified in section II of this brief, and therefore there are no decisions rendered by a court or the Board in any proceeding included in this section.